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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,590	07/30/2002	Christine Gaertner	H4304PCT/US	9446

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COGNIS CORPORATION
PATENT DEPARTMENT
300 BROOKSIDE AVENUE
AMBLER, PA 19002

EXAMINER

LAMM, MARINA

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 02/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 10/070,590	Applicant(s) GAERTNER ET AL.	
	Examiner Marina Lamm	Art Unit 1616	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 8-17.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 5. does NOT place the application in condition for allowance because: the Applicants' arguments are not found persuasive. The Applicants argue that they "have shown that compositions containing the claimed components in amounts within the claimed ratio by weight range exhibit significantly improved sun protection results and that this improvement is surprising". See p. 4 of the Remarks. Applicants further note that "the Federal Circuit has held that 'the PTO must consider' comparisons in the specification when determining whether the claimed invention is unobvious." *Id.* In response, it is noted that the Examples in the Applicants' specification compare the claimed composition containing beta-carotene, lycopene and lutein (1:1:1) to the composition containing only beta-carotene or no carotenoids at all. The composition according to the instant invention shows improved photoprotection in comparison to these compositions. In contrast, the oral compositions of Runge contain all claimed ingredients (i.e. beta-carotene, lycopene and lutein). While Runge lacks specific examples of the amounts within the claimed ranges, such amounts of ingredients are broadly disclosed. Thus, the Examples in the specification, while demonstrating that the composition containing beta-carotene, lycopene and lutein (1:1:1) shows improved photoprotection in comparison to the composition containing beta-carotene as the only carotenoid or no carotenoids at all, do not demonstrate unexpected results over the closest prior art, i.e. Runge. Further, in response to applicant's argument that there is no suggestion to combine the references (see pp. 4-5 of the Remarks), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is found in either Riley or Gellermann et al. which teach that carotenoid-containing oral formulations useful for protecting against UV radiation and aging due to the effects of solar radiation. See Riley at col. 7, lines 58-63; col. 8, lines 40-45; col. 20-21, Table; Gellermann et al. at col. 8, lines 12-19, 30-40. One of ordinary skill would have been motivated to use the oral formulations of Runge et al. for protecting the skin from damaging effects of sunlight and for inhibiting skin aging, with a reasonable expectation of success because Riley or Gellermann et al. suggest that the claimed combination of carotenoids is effective in protecting the skin from solar radiation which can lead to premature skin aging.


2/4/04

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